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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,980	02/09/2004	Elizabeth M. Doherty	A-824	1288

7590 02/17/2006

U.S. Patent Operations/RVP
Dept. 4300, M/S 27-4-A
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Thousand Oaks, CA 91320-1799

EXAMINER

CHANG, CELIA C

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/775,980

Applicant(s)

DOHERTY ET AL.

Examiner

Celia Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 6-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1 and 6-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application is a RCE of SN 10/775,980. Claims 2-5 have been canceled. Claims 1, 6-20 newly presented are subject to the following restriction.

2. *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 7 and 11, drawn to compounds wherein Q^1 - Q^4 are CR^{5-7} , X^2 , X^3 are CR^{8-9} , classified in class 548, subclass various depending on species election. If this group is elected, claims 1, 6, 8-10, 14-20 reading on the elected compound can be prosecuted with the elected compound. A further election of a single disclosed species is also required. Further restriction based on the elected species may be required.
- II. Claims 7 and 12-13, drawn to compounds wherein Q^1 - Q^4 are CR^{5-7} , one of X^2 , X^3 is N, classified in class 546, subclass various, depending on species election. If this group is elected, claims 1, 6, 8-10, 14-20 reading on the elected compound can be prosecuted with the elected compound. A further election of a single disclosed species is also required. Further restriction based on the elected species may be required.
- III. Claims 1, 6 and 12-13, drawn to compounds wherein one of Q^1 - Q^4 is N, the remaining are CR^{5-7} , one of X^2 , X^3 is N, classified in class 546, subclass various, depending on species election. If this group is elected, claims 1, 6, 8-10, 14-20 reading on the elected compound can be prosecuted with the elected compound. A further election of a single disclosed species is also required. Further restriction based on the elected species may be required.
- IV. Claims 1, 6, 8-10, 14-20, drawn to compounds wherein Q^1 - Q^4 are CR^{5-7} , both X^2 and X^3 are N, classified in class 544, subclass various, depending on species election. A further election of a single disclosed species is also required. Further restriction based on the elected species may be required.

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- V. Claims 1, 6, 8-10, 14-20, drawn to compounds wherein multiple Q^1 - Q^4 are N and the remaining are CR^{5-7} , both X^2 and X^3 are N, classified in class 544, subclass various, depending on species election. A further election of a single disclosed species is also required. Further restriction based on the elected species may be required.

The inventions are independent or distinct, each from the other because:

The core structure of groups I-V are so disparate chemically as not to be recognized by the art to belong to a known chemical class of compounds. MPEP 803.02 set forth guidelines for Markush claims to be proper if the groups of compounds (1) share a common utility **and** (2) share a *substantial* structural feature *disclosed as being essential to that utility*.

In the instant case, the benzimidazolyl phenylaminethiaolyl core (see RN 14521-72-3 CA 66:65472) i.e. X1 is S species of group I, has been known to have anthelmintic activity; the N-phenylcarboximideoxazolylmethylphenyl core (see RN 98511-88-7 CA 58:53202) i.e. X1 is O species of group I, has been known to have antitubercular activity; the benzimidazolyl thiazolylamino pyridine core (see RN 620603-49-8 CA 139:364922) i.e. group III one of Q^1 - Q^4 is N is compounds, has been known to have antitumor activity. Therefore, clear evidence indicated that the instant Markush format lacks the commonality in sharing a substantial structural feature disclosed as being essential to that utility. The art recognized cores as embraced by the instant Markush groups have been shown not to belong to the same class of structurally related variations. The searches for each group is not coextensive of each other and within each group, separate searches must be conducted for separate core i.e. X1 is N, O or S, which is a tremendous burden were restriction not made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a group and a species within the elected group to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of a group or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

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Should applicant traverse on the ground that the groups or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, then there could have been no patentability of all the claims over the above recited prior art, and the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of all the claims.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Feb. 15, 2006



Celia Chang
Primary Examiner
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